REMARKS

I.   Overview

These remarks are set forth in response to the Non-Final Office Action.

Presently, claims 1 through 13 are pending in the Patent Application. Claims 1, 6 and 9

are independent in nature. In the Non-Final Office Action, Examiner has rejected claims

6 through 8 under 35 U.S.C. § 112, second paragraph. Further, Examiner has rejected

claims 1 through 5 and 6 through 8 under 35 U.S.C. § 101. Even yet further, claims 1

through 5, 6 through 7 and 9 through 13 under 35 U.S.C. § 102(b) as being anticipated by

U.S. Patent Application Publication No. 2003/00614333 by Hall et al. (Hall). Finally,

Examiner has rejected claim 8 under 35 U.S.C. § 103(a) as being unpatentable over Hall

in view of Examiner's Official Notice.

II.   The Applicants' Invention

The Applicants have invented a system, method and apparatus for applying

ordered modifications to recurring event instances. In accordance with the present

invention, an event storage model can include event data and a corresponding recurrence

rule for each recurring event. Actual event instances can be calculated on demand based

upon the recurrence rule. Notably, modifications to the event instances can specified

separately for specific event properties in the event instance. Only the modified

properties can be stored as an "event exception". In this way, modifications to the event

instances can be calculated concurrently with the dynamic calculation of the event

instances based upon the recurrence rule. Finally, stale event exceptions which have

become obviated by the application of subsequent event exceptions can be purged from the storage model periodically.

III.   Rejections under 35 U.S.C. § 112, Second Paragraph

There are two separate requirements set forth in 35 U.S.C. § 112, second paragraph. As described in M.P.E.P. 2171, (A) the claims must set forth the subject matter that applicants regard as their invention; and (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. The first requirement is a subjective one because it is dependent on what the applicants for a patent regard as their invention. The second requirement is an objective one because it is not dependent on the views of applicant or any particular individual, but is evaluated in the context of whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.

In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent.[1] As such, if the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim

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[1] See, e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000).

so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C.

112, second paragraph, would be appropriate.[2]. However, if the language used by

applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the

examiner merely wants the applicant to improve the clarity or precision of the language

used, the claim must not be rejected under 35 U.S.C. 112, second paragraph, rather, the

examiner should suggest improved language to the applicant.[3]

On page 2 of the Non-Final Office Action, Examiner argues that claims 6 through

8 fail under 35 U.S.C. § 112, second paragraph because while claim 6 recites a

calendaring system, the body of claim 6 is "not commensurate with [the] understood

definition of a system or apparatus" and that claim 6 merely recites "functional

descriptive material". In response, Applicant has amended claims 6 and 7 to specifically

recite the presence of a computer system with processor and memory as set forth in

paragraph [0028] of Applicant's specification and the execution of a calendaring system

therein as described in paragraph [0016] of Applicant's specification. Amended claims 6

and 7 further expand upon the structure configuration of each of the recurrence event

expander, the recurrence event modifier, and the modification rule reducer. Accordingly,

Applicant believes the foregoing amendments add no new matter and satisfy Examiner's

concerns with respect to 35 U.S.C. § 112, second paragraph.

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[2] See Morton Int'l, Inc. v. Cardinal Chem. Co., 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993)
[3] M.P.E.P. 2173.02

IV.   Rejections Under 35 U.S.C. § 101

The law of non-statutory subject matter has become clear subsequent to the issuance of the present Non-Final Office Action. In this regard, the Court of Appeals for the Federal Circuit in deciding Ex Parte Bilski[4] has now set forth important legal guidelines for adjudicating the statutory nature of a claim under 35 U.S.C. § 101. Specifically, the nine-member majority opinion (penned by Chief Judge Michel) spelled out the "machine-or-transformation" test as the sole test of subject matter eligibility for a claimed process. More particularly, the opinion states,

> The Supreme Court ... has enunciated a definitive test to determine whether a process claim is tailored narrowly enough to encompass only a particular application of a fundamental principle rather than to pre-empt the principle itself. A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.
> ....
> Because the applicable test to determine whether a claim is drawn to a patent-eligible process under § 101 is the machine-or-transformation test set forth by the Supreme Court and clarified herein.

Accordingly, under Bilski, Applicants' amended claims 1 through 5 recite statutory subject matter given the presence of an apparatus tied to the execution of the method.

In this regard, for the convenience of the Examiner, amended claim 1 is reproduced herein in its entirety as follows:

> 1.   A method for applying ordered modifications to recurring event instances, the method comprising the steps of:
>   identifying an event exception **in a calendaring system executing in memory by a processor of a computer**, the event exception corresponding to a separately defined and separately stored recurring event instance in the calendaring system; and,
>   modifying **within the calendaring system** at least one property of said recurring event instance based upon said separately stored event exception.

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[4] Appeal No. 2007-1130 (Fed. Cir. October 30, 2008).

Thus, the claimed limitation of "identifying an event exception in a calendaring system executing in memory by a processor of a computer" and the limitation of "modifying within the calendaring system" satisfy the machine portion of the machine-or-transformation test of <u>Bilski</u>. Accordingly, claim 1 and by extension claims 2 through 5 recite statutory subject matter. Further, the amendments to claims 6 through 8 discussed *infra* further recite an apparatus sufficient to satisfy Examiner's concerns with respect to 35 U.S.C. § 101.

V.   Rejections Under 35 U.S.C. § 102(e)

A.   Characterization of the Cited Art

Hall claims a system and method for synchronizing records stored in differing formats in a shared data environment. One aspect of Hall describes distinguishing a record without regard to its format. Once a record is introduced into the environment, it is detected. A record file is generated and associated with the event. The record file typically includes a record tag uniquely identifying a given record in the shared data environment and a record type indicating information such as whether or not the record represents a recurring event as well as the format of the record. The record file also contains data indicating the status of the particular event, that is, whether it is new, unchanged, modified, or deleted. When synchronizing, only those records with equivalent record tags are compared. The record type and status are then used to guide the synchronization of equivalent records.

B.   Traversal of the Rejections on the Art

The factual determination of anticipation under 35 U.S.C. § 102 requires the

identical disclosure, either explicitly or inherently, of each element of a claimed invention

in a single reference.[5] Moreover, the anticipating prior art reference must describe the

recited invention with sufficient clarity and detail to establish that the claimed limitations

existed in the prior art and that such existence would be recognized by one having

ordinary skill in the art.[6] Absence from an allegedly anticipating prior art reference of

any claimed element negates anticipation.[7]

On page 4 of the Non-Final Office Action, Examiner refers to paragraph [0004] of

Hall in sole support of the assertion that Hall describes the invention with sufficient

clarity and detail to establish that the claimed limitations of claim 1 exist in Hall and that

such existence would be recognized by one having ordinary skill in the art. For the

convenience of Examiner, claim 1 *as amended* provides:

> 1.   A method for applying ordered modifications to recurring event instances, the
> method comprising the steps of:
>
>   identifying an event exception in a calendaring system executing in memory by
> a processor of a computer, the event exception corresponding to a separately defined **and
> separately stored** recurring event instance in the calendaring system; and,
>
>   modifying within the calendaring system at least one property of said recurring
> event instance based upon said **separately stored** event exception.

Integral to amended claim 1 is the separate storage of the event exceptions from

corresponding event instances modified by the event exceptions.

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[5] In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every
limitation of the claimed invention, either explicitly or inherently"), In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955
(Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226,
1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221
USPQ 669, 673 (Fed. Cir. 1984).
[6] See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps Inc.,
850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).
[7] Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986)(emphasis added).

The teachings of paragraph [0004] of Hall provide an opposite teaching. For the convenience of Examiner, paragraph [0004] is reproduced as follows:

[0004] Where the shared data applications on each device use the same file formats, synchronization is a relatively simple process. However, modern computing environments tend to be more complex, often having devices from multiple manufacturers, each with differing file formats making it difficult, if not impossible, to accurately synchronize shared data. This is often the case with calendaring applications. Records representing the same event are often stored in different formats on different devices. **More specifically, some calendaring applications have the capability of representing a recurring appointment with a single complex record. A complex record typically contains a general rule and one or more exceptions.** A general rule identifies information such as a beginning date and an ending date for the recurring appointment, the days of the week, month, or year on which the appointment falls, and a time for each of those days. An exception is a variance from the general rule. Exceptions fall into two categories: deletions--when an appointment does not occur, for example, on a given day or for a given week; and modifications--when the time, location, or other data for an appointment on a given day is changed. For example, a child's soccer practice might occur every Tuesday and Thursday from 5:30 to 6:30 PM in the months of March and April. There are, however, exceptions--the starting time for the second Tuesday in April will be 4:30 PM instead of 5:30, and there is no practice on the first Thursday in May.

Thus, in Hall, both the exceptions to recurring appointments are stored in a single complex record and are not separately stored as required by each of Applicant's amended claims 1, 6 and 9.

VI.   Conclusion

Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §§ 101, 112, 102(e) and 103(a) owing to the clearly distinctive nature of Applicant's invention as recited in <u>amended</u> claims 1, 6 and 9. The Applicant requests that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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